



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 21, 2004

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000
US

Dear Sir/Madam,

Your refund request for 10706480 in the amount of \$130.00 has been denied .

The Petition was denied therefore the refund is denied.

Sincerely,

ELEANOR KURTZ
Office of Initial Patent Examination
703 308-3642

Attorney's Docket No. 038190/268379

07-26-04

PATENT & TRADEMARK OFFICE
DIVISION #307
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Burford *et al.*

Appl. No.: 10/706,480

Applicant Filed: October 27, 2003

USPTO Date Entered: April 7, 2004

For:

SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW)
ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING
A FRICTION STIR WELDING OPERATION

Confirmation No.: 8066 2004 JUL 30 PM 3:10
Group Art Unit: 1725



Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Request for Reconsideration of
Petition To Grant Filing Date And To Refund Petition Fee

This is a Request for Reconsideration of our Petition filed April 7, 2004, wherein Applicants petitioned to grant the proper filing date of October 27, 2003, for the above-identified patent application.

Applicants' Petition was dismissed June 10, 2004. The Petitions Examiner has stated that Applicants have not submitted a proper return postcard showing that the application was filed October 27, 2003. However, the Patent Office did not properly stamp Applicants' postcard. Instead, the Patent Office returned Applicants' postcard with the stamp by the Office of License and Review and the date that the Office of License and Review received it. Therefore, it is the Patent Office who improperly stamped Applicants' postcard, thereby leaving Applicants without a properly stamped postcard to produce as evidence.

On October 27, 2003, Applicants sent a United States Postal Service Package to Mail Stop Patent Application (see Exhibit A). The package contained two filings for the same invention: 1) a complete application as outlined on Applicants' return postcard (see Exhibit B); and 2) a Request for Foreign Filing License accompanied by a copy of the specification and drawings as well as another return postcard specifically drawn to the Request for Foreign Filing License (see Exhibit C).

Both of Applicants' postcards are stamped "Received Oct. 30, 2003 Licensing & Review." Applicants can only surmise that when the package was received by Patent Office

In re: Burford *et al.*
Appl. No.: 10/706,480
Applicant Filed: October 27, 2003
USPTO Date Entered: April 7, 2004
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PATENT MAINTENANCE
DIVISION

2004 JUL 30 PM 3:10

personnel at Mail Stop Patent Application, the package was not separated out into two different filings, each being separately clipped together by Applicants along with its own postcard. The patent application was not retained for proper processing and stamping of the postcard with an application number and the correct date of October 27, 2003. But instead, the complete application with 25 pages of specification and six pages of drawings and other accompanying documents, as well as the Petition for Foreign Filing License with its copy of the specification and drawings, were forwarded to Licensing and Review, which stamped both postcards October 30, 2003. Only the Petition for a Foreign Filing License and the copy of the specification attached to it with its postcard clipped on top should have been forwarded to Licensing and Review.

As further evidence that the Patent Office did indeed receive a complete copy of the specification and drawings, Applicants also submit herewith as Exhibit D a copy of the foreign filing license granted by the Office of License and Review on October 31, 2003. According to 37 C.F.R. §§ 5.13 and 5.14, when a petition for a foreign filing license is made in the Patent Office, the petition must be accompanied by the material or the disclosure of a patent application upon which the desired license is measured. Since the Office of License and Review granted a foreign filing license for the present application on October 31, 2003, the Patent Office must have had the specification and drawings as the measure upon which the license was granted at least as far back as October 30, 2003, the date stamped on the return postcard and indicated as being the request date on the foreign filing license. Moreover, since the specification and drawings must have accompanied the petition, and the petition for a foreign filing license was included in the aforementioned United States Postal Service Package sent on October 27, 2003, the specification and drawings of the present application must have also been included in the aforementioned package.

Applicants therefore respectfully request that the filing date of October 27, 2003 (the date on the Express Mail Label which date also appears on Applicants' return postcard) be granted. Applicants further believe that if the Examiner cannot grant this date, that there is a preponderance of evidence that the Patent Office had the complete application on October 30, 2003. The Applicants should not be burdened because Patent Office personnel improperly

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In re: Burford *et al.*
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Applicant Filed: October 27, 2003
USPTO Date Entered: April 7, 2004
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handled the application by forwarding both separately clipped sets of documents to Licensing and Review, and did not hold and process the application that was separately clipped with its own postcard. Moreover, Applicants' petition should not be denied because of the improper processing of the present application and the improper stamping of Applicants' return postcard has left Applicants without the postcard the Petitions Examiner is requesting.

It is Applicants' understanding that there is no charge for a Request for Reconsideration of our Petition. And because no defect existed in Applicants' originally filed patent application, Applicants request a filing date of October 27, 2003, and respectfully also request a refund of the previously paid \$130.00 petition fee.

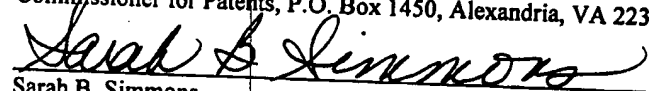
Respectfully submitted,


Andrew T. Spence
Registration No. 45,699

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

"Express Mail" mailing label number EV 331631265 US
Date of Deposit July 23, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Sarah B. Simmons
CLT01/4658231v1

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DIVISION

Exhibit A

Copy of Applicant's U.S. Postal Service Express Mail label.

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Customer Copy
Label 11-F June 2002



UNITED STATES POSTAL SERVICE

Post Office To Addressee

ORIGIN (POSTAL USE ONLY)	
No ZIP Code	Day of Delivery
Date in	Flat Rate Envelope
Mo. Day Year	Postage
Time	Return Receipt Fee
AM PM	Weight
lbs. ozs.	Initial Alpha Country Code
No Delivery	COD Fee
Island	Insurance Fee
Holiday	Acceptance Clerk Initials
CUSTOMER USE ONLY	Total Postage & Fees
PERIOD OF PAYMENT	
United Mail Corporate Acct. No.	

DELIVERY (POSTAL USE ONLY)	
Delivery Attempt	Time
Mo. Day	AM PM
Delivery Attempt	Time
Mo. Day	AM PM
Delivery Date	Time
Mo. Day	AM PM

FROM: (PLEASE PRINT)	PHONE: 704 444 1000
ALSTON & BIRD LLP	
BANK OF AMERICA PLAZA	
101 S TRYON ST STE 4000	
CHARLOTTE NC 28280-4000	
HTS: 03890-268379	

TO: (PLEASE PRINT)	
MAIL STOP PATENT APPLICATION	
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Product Description	Sales Receipt	Unit Price	Final Price
Express Mail PO-ADD Flat			\$13.65
Serial Number EL822754693US			
2nd Day 3PM / Normal			
Delivery			
Paid by account:			\$13.65
EMCA account number:			282641
ALEXANDRIA VA 22313			\$17.85
Express Mail PO-ADD			
Serial Number EV331608718US			
Next Day Noon / Normal			
Delivery			
Paid by account:			\$17.85
EMCA account number:			282641
Total:			\$0.00
Paid by:			

111#: 1000400559745
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PATENT MAINTENANCE
DIVISION

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Exhibit B
Applicant's Patent Application Postcard

This postcard was clipped on top of the complete application filing. All of the documents listed on the postcard were enclosed.

Mail Stop Patent Application

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Date Mailed: 10-27-03

Atty. Dkt. No. 038190/268379

Kindly acknowledge receipt of the accompanying utility PATENT APPLICATION with Application Transmittal Cover Sheet for:

Inventor(s): Dwight R. Burford, Edwin H. Fenn, Danny R. High, Robert M. May

Title of Invention: SYSTEM AND ASSOCIATED FRICTION STIR (FSW) ASSEMBLY
CONTROLLER AND METHOD FOR PERFORMING A FRICTION STIR WELDING OPERATION

Pages of Spec. (including claims and abstract) 25; No. of Claims 20
No. of Drawing Sheets 6; Declaration Enclosed YES (3 pages); IDS with PTO
1449 Enclosed YES; (No. of 1449 Cites Enclosed 1); Assignment with Cover
Sheet and \$40.00 Fee Enclosed YES

Other Documents: Request for Early Publication; Petition for License for Foreign Filing
Check(s) Enclosed \$856.00; \$300.00; \$130.00; \$40.00

Please place office stamp hereon and Return Postcard to : Sarah B. Simmons/ATS
ALSTON & BIRD LLP

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PATENT MAINTENANCE
DIVISION

2004 JUL 30 PM 3:10

Exhibit C

Applicant's Petition for Foreign Filing License Postcard

This postcard was clipped on top of the Petition for Foreign Filing License with a copy of the Specification and Drawings attached.

ATTENTION: Licensing and Review

Mail Stop Patent Application

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Date Mailed: 10-27-03

Atty. Dkt. No. 038190/268379

Application No. (To be assigned) ; Filing Date (Concurrently herewith)

Inventor(s): Dwight A. Burford, Edwin H. Fenn, Danny R. High, Robert M.

**Key: Title of Invention: SYSTEM AND ASSOCIATED FRICTION STIR
WELDING (FSW) ASSEMBLY, CONTROLLER AND METHOD FOR
PERFORMING A FRICTION STIR WELDING OPERATION**

Documents Enclosed: Petition for License for Foreign Filing

Check Enclosed \$130.00

**Kindly acknowledge receipt by placing office stamp hereon and
returning postcard to: Sarah B. Simmons/ATS**

ALSTON & BIRD LLP

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Exhibit D
Copy of Applicants' Foreign Filing License Granted Oct. 31, 2003

2004 JUL 30 PM
ATB



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
P-108,165	10/30/03	DWIGHT A. BURFORD, ET AL.	038190/268379

Title:

**SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW)
ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING A
FRICTION STIR WELDING OPERATION**

Correspondence Address:

ANDREW T. SPENCE
ALSTON & BIRD LLP
BANK OF AMERICA
101 SOUTH TRYON STREET, SUITE 400
CHARLOTTE, NC. 28280

Art Unit	Paper Number
----------	--------------

Alston & Bird

NOV 7 2003

Received By

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 531,532
Grant Date: 31-Oct-03

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



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SUITE 4000
CHARLOTTE NC 28280-4000

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JUN 10 2004

OFFICE OF PETITIONS

In re Application of :
Burford, et al. :
Application No. 10/706,480 : DECISION DISMISSING PETITION
Filed: April 7, 2004 :
Attorney Docket No. 038190/268379 :

This is a decision on the "Petition to Grant Filing Date and to Refund Petition Fee", filed April 7, 2004.

Application papers in the above-identified application were deposited on October 27, 2003. However, on March 29, 2004, the Initial Patent Examination Division mailed applicant a "Notice of Incomplete Nonprovisional Application." Applicants were notified that the application papers had not been accorded a filing date because the application was deposited without a specification. This Notice set a two month period for reply.

In response, on April 7, 2004, Applicants filed the present petition to accord a filing date of October 27, 2003. Applicants asserted that a complete application, including a specification, was filed on October 27, 2003. As proof thereof, applicants have submitted: (1) a copy of the original application transmittal letter, bearing Express Mail Label No. EV 331608718 US, and itemizing the items allegedly filed with the application, including 25 pages of specification; (2) a copy of the Express

Mail label bearing Express Mail Label No. EV 331608718 US, and a date-in of October 27, 2003; and (3) a copy of a postcard receipt, itemizing the application, but lacking a USPTO date stamp dated October 27, 2003.¹

The PTO file is the official record of papers originally filed in this application. A review of the official file reveals that a specification was not filed on October 27, 2003, since those papers are not present in the file. An applicant alleging that a paper was filed in the PTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence.

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See MPEP 503. Applicants have not submitted a proper return postcard showing that the application was filed on October 27, 2003.

Furthermore, petitioner may not rely upon Express Mail under 37 CFR 1.10(e) to establish that the specification was filed with the instant application. MPEP 513 states, in pertinent part:

37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost *in toto* (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

¹ The postcard receipt did contain a stamp marked "Received October 30, 2003 Licensing and Review."


Here, the application file contains some papers that were filed on October 27, 2003; specifically a Utility Patent Application Transmittal, a Request for Early Publication, a 37 CFR 1.63 declaration, and an IDS.

Accordingly, the petition is DISMISSED.

The application will be accorded a filing date based upon the date that the missing specification was received in the Office, or April 7, 2004.

The application file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of April 7, 2004, using the application papers submitted on October 27, 2003, together with the 25 pages of specification and the 6 sheets of drawings filed on April 7, 2004.

Telephone inquiries related to this decision should be directed to Petitions Attorney Cliff Congo at 703-305-0272.

 for

Charles Pearson
Director
Office of Petitions